



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,958	07/12/2001	Hidetoshi Onaka	15689.75	9404

7590

06/15/2006

ADRIAN J. LEE
WORKMAN, NYDEGGER & SEELEY
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111

EXAMINER

KNOWLIN, THJUAN P

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/903,958	Applicant(s) ONAKA ET AL.	
	Examiner Thjuan P. Knowlin	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's RCE and amendment filed on March 21, 2006 have been entered. Claims 1, 6, 7, and 9 have been amended. No claims have been cancelled. No claims have been added. Claims 1-10 are still pending in this application, with claims 1, 6, 7, 8, 9, and 10 being independent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serbetcioglu et al (US 5,511,111), in view of Young et al (US 6,324,405).
3. In regards to claims 1, 6, 7, and 9, Serbetcioglu discloses a mobile communication system (See Fig. 1 and telecommunications network 300) comprising a mobile terminal (See Fig. 1 and subscriber stations 324) and a subscriber information management apparatus (See Fig. 1 and VLR 327) that manages subscriber information (See col. 7 lines 19-29), and wherein said subscriber information management apparatus comprises: receiving means for receiving said first subscriber (e.g., calling subscriber) identity information (e.g., voice identification) along with said second

subscriber (e.g., called subscriber) identity information (e.g., voice identification) from said mobile terminal; and registering means for registering location area information of said first subscriber identity information as location area information associated with said second subscriber identity information (See col. 7 lines 6-29). Serbetcioglu, however, does not disclose the system wherein said mobile terminal comprises: detecting means for detecting a loading of a plurality of recording media, each of the plurality of recording media storing a subscriber identity to be sent to said subscriber information management apparatus; and transmitting means for transmitting, when said detecting means detects at least two recording media, first subscriber identity information corresponding to a first recording medium along with second subscriber identity information corresponding to a newly detected recording medium, to said subscriber information management apparatus. Young, however, discloses detecting means (See Fig. 2 and smart card reader 33) for detecting a loading of a plurality of recording media (See Fig. 2, smart card (SIM) 35 and Fig. 11, SIM 35), each of the plurality of recording media storing a subscriber identity (e.g. subscriber identity modules, See col. 7 lines 41-45) to be sent to said subscriber information management apparatus (See Fig. 16 and ID's/store 330) (See col. 16 lines 13-18); and transmitting means for transmitting, when said detecting means detects at least two recording media, first subscriber (See Fig. 1, mobile user terminal equipment 2a and fixed terminal equipment 12a) identity information corresponding to a first recording medium along with second subscriber (See Fig. 1, mobile user terminal equipment 2b and fixed terminal equipment 12b) identity information corresponding to a newly detected

recording medium (See col. 7 lines 32-45 and col. 16 lines 13-18), to said subscriber information management apparatus (See col. 16 lines 13-18). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to employ these features within the system, as a way of allowing a telephone call to be facilitated from any valid mobile phone since the subscriber data is used to complete the call rather than the telephone internal serial number.

4. In regards to claim 2, Serbetcioglu discloses all of claim 2 limitations, except the mobile communication system, wherein said recording media is a subscriber identity module card. Young, however, discloses the mobile communication system, wherein said recording media is a subscriber identity module card (See Fig. 2, SIM 35 and Fig. 11, SIM 11) (See col. 7 lines 32-45).

5. In regards to claim 3, Serbetcioglu discloses all of claim 3 limitations, except the mobile communication system, wherein said first subscriber identity information is subscriber identity information stored in said first recording medium or temporary subscriber identity information corresponding to the subscriber identity information stored in said first recording medium, and said second subscriber identity information is subscriber identity information stored in said newly detected recording medium. Young, however, discloses the mobile communication system, wherein said first subscriber identity information is subscriber identity information stored in said first recording medium or temporary subscriber identity information corresponding to the subscriber identity information stored in said first recording medium, and said second subscriber

identity information is subscriber identity information stored in said newly detected recording medium (See col. 10 lines 50-60, col. 14 lines 7-13, col. 14 lines 27-35).

6. In regards to claim 4, Serbetcioglu discloses all of claim 4 limitations, except the mobile communication system, wherein said first subscriber identity information and said second subscriber identity information are associated with respective telephone numbers. Young, however, discloses the mobile communication system, wherein said first subscriber identity information and said second subscriber identity information are associated with respective telephone numbers (See col. 9 lines 19-27).

7. In regards to claim 5, Serbetcioglu discloses all of claim 5 limitations, except the mobile communication system, wherein said first subscriber identity information and said second subscriber identity information are associated with mail addresses. Young, however, discloses the mobile communication system, wherein said first subscriber identity information and said second subscriber identity information are associated with mail addresses (See col. 10 lines 50-60).

8. In regards to claims 8 and 10, Serbetcioglu discloses all of claims 8 and 10 limitations, except a mobile network system comprising: managing means for managing communication state of a mobile terminal having at least two telephone numbers; judging means for judging, when an incoming call to said mobile terminal occurs, whether said mobile terminal is in communication by using any one of said telephone numbers, based on said communication state; and processing means for performing a process for said incoming call in accordance with said judgment. Young, however, discloses a mobile network system (See Fig. 1) comprising: managing means for

Art Unit: 2614

managing communication state of a mobile terminal having at least two telephone numbers; judging means for judging, when an incoming call to said mobile terminal occurs, whether said mobile terminal is in communication by using any one of said telephone numbers, based on said communication state; and processing means for performing a process for said incoming call in accordance with said judgment (See col. 12 lines 12-25).

Response to Arguments

9. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Raffel (US 6,223,042) teaches a method of intelligent roaming using network information.

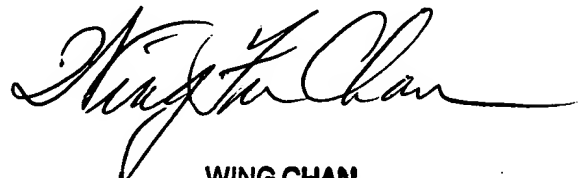
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thjuan P. Knowlin whose telephone number is (571) 272-7486. The examiner can normally be reached on Mon-Fri 8:30-5:00pm.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan can be reached on (571) 272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2614

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thjuan P. Knowlin



WING CHAN
SENIOR PRIMARY EXAMINER
TECHNOLOGY CENTER 2600